

glass, in most of their glasses they use none at all and in others amounts far exceeding applicants' upper limit of 2.5%.

Summarizing, Steierman does not suggest the specifically claimed amounts of SrO and BaO, nor the addition of ZrO<sub>2</sub> as an X-ray absorption component, or TiO<sub>2</sub> as an agent preventing browning of the panel glass by ultraviolet rays. He uses cerium oxide to protect against X-ray browning (col. 6, lines 37/8). The funnel glass of Yanagisawa et al contains at least 5% PbO and uses TiO<sub>2</sub> to adjust the viscosity of the glass. A person of ordinary skill in the art would not glean from this teaching that TiO<sub>2</sub> prevents browning of a CRT panel by ultraviolet radiation. This modification can be gleaned only from applicants' teaching and finds no suggestion in the prior art. While Petersen et al suggest the optional use (0%) of up to 14% ZrO<sub>2</sub> as an X-ray absorbing agent in funnel glass (of a totally different composition), applicants use the specific amount of 0.1-2.5% amount of ZrO<sub>2</sub> in their panel glass.

While the references are "in the same field of tube manufacture," none of the cited patents addresses the specific problem solved by applicants, i.e. the prevention of the production of devitrification stones resulting from the claimed amounts of SrO and BaO. The selection of these amounts is not

obvious from Steierman, and the combination of Yanagisawa et al and Petersen et al with Steirman is not obvious from the disclosures in the prior art but is only suggested by applicants' teaching. As the Court held in *In re Imperato*, 179 USPO 730,

"... the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination (emphasis by court)."

It is respectfully submitted that the secondary and tertiary references do not "suggest the desirability of the combination" with the primary reference.

In *In re Shaffer*, 1956 C.D. 138, the Court held that references

"may not be combined indiscriminately, and to determine whether the combination of references is proper, the following criterion is often used: namely, whether the prior art suggests doing what an applicant has done ... The art applied should be viewed by itself to see if it has fairly disclosed what an applicant has done. If the art did not do so, the references may have been improperly combined ... In fact, a person having the references before him who was not cognizant of appellant's disclosure would not be informed that the problems solved by appellant ever existed. Therefore, can it be said that these references which never recognized appellant's problem would have suggested its solution? We think not, and therefore feel that the references were improperly combined since there is no suggestion in either of the references that they can be combined to produce appellant's results."

It is respectfully submitted that "a person ... who was not cognizant of (applicants') disclosure would not be informed that the problems solved by (applicants) ever existed" (preventing precipitation of devitrification stones) and "therefore ... the references were improperly combined since there is no suggestion in either of the references that they can be combined to produce (applicants') results."

In a very recent decision, the Board of Patent Appeals and Interferences, *Ex parte Hillyer*, 68 USPQ2d 1222, agreed with appellants

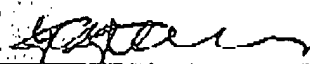
"that (the prior art) does not teach the combination of oxygen and ammonia is effective for the uses claimed by appellants... In our view, (the prior art) provides evidence that the artisan was familiar with the use of the listed additives and with the particular applications to which they were suited... We believe that the evidence relied upon falls short of establishing prima facie obviousness of the claimed invention...it appears that no more than an 'obvious to try' standard has been met. However, this is not the standard of 35 U.S.C. 103."

Thus, while the prior art shows  $\text{TiO}_2$  to be suited for adjusting viscosity of a different glass, it falls short of suggesting its use for prevent browning of a CRT panel glass.

A sincere effort having been made to overcome the grounds of rejection, favorable reconsideration and allowance of claims 1-13 and 16-19 are respectfully solicited.

Respectfully submitted,

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I hereby certify that this correspondence is being faxed to the US PTO, Fax No.: 703-872-9319, on November 12, 2003.

  
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